

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Tatsuhiko HATANO et al.

Application No.: New U.S. National Stage of PCT/JP2004/015993

Filed: April 18, 2006

Docket No.: 127737

For: PULSE GENERATOR CIRCUIT

**ALTERNATIVE PETITION UNDER 37 C.F.R. §1.137(b) TO REVIVE
UNINTENTIONALLY ABANDONED APPLICATION OR UNDER 37 C.F.R. §1.182
FOR WITHDRAWAL OF UNINTENTIONAL EXPRESS ABANDONMENT**

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby petition in the alternative for (1) revival of an unintentionally abandoned application under 37 C.F.R. §1.137(b) or (2) withdrawal of an unintentional express abandonment (withdrawal) of the U.S. designation of a PCT application under 37 C.F.R. §1.182, either option resulting in entry and consideration of the attached U.S. National Stage patent application.

Because of the nature of this Petition, and after consultation with a Legal Examiner in the PCT Branch of the U.S. Patent and Trademark Office, the following statement of facts and discussion is provided.

I. Statement of Facts

1. International PCT Application No. PCT/JP2004/15993 was filed in the Japanese Patent Office as the PCT Receiving Office on October 28, 2004. The international

PCT application as filed designated the United States for future filing of a U.S. National Stage application.

2. The international PCT application claimed priority under the Paris Convention to an earlier filed Japanese patent application, application no. 2003-366815 filed October 28, 2003.

3. The thirty-month time limit for entering the U.S. National Stage of the international PCT application is April 28, 2006.

4. On January 18, 2005, the U.S. designation was inadvertently and unintentionally withdrawn, leading to abandonment of the U.S. National Stage application. The Withdrawal of Designation was forwarded by registered mail to the Japan Patent Office on January 17, 2005, and received by the Japan Patent Office on January 18, 2005.

5. The intended withdrawal of designation was to withdraw the Japanese designation, because otherwise under then-current Japanese law and PCT regulations, the filing of an international application designating Japan would have resulted in the undesired automatic withdrawal of the earlier filed Japanese priority application. Applicants representative thus intended to file a withdrawal of only the Japan designation in the international application.

6. An office secretary of Applicants' international representative prepared, stamped, and filed the Withdrawal of Designation. In doing so, the secretary inadvertently and unintentionally listed the "United States of America" rather than the proper "Japan" as the designation to be withdrawn.

7. According to Japanese practice, the Withdrawal of Designation paper was not signed by hand by Applicants' international representative, but was stamped by the secretary. The stamped seal takes the place of a formal personal signature under Japanese law. The withdrawal of the U.S. designation was thus inadvertently and unintentionally filed by the

office secretary of Applicants' international representative, where the withdrawal of designation request listed "United States of America" rather than the proper "Japan."

8. The secretary that inadvertently and unintentionally filed the withdrawal of the U.S. designation left employment of Applicants' international representative in September 2005, and the inadvertent and unintentional withdrawal of the U.S. designation was not discovered until April 12, 2006.

9. This Petition and the accompanying U.S. National Stage application filing are being filed immediately upon discovery of the inadvertent and unintentional withdrawal of the U.S. designation, and prior to expiration of the time limit for filing the U.S. National Stage application.

II. Petition Under 37 C.F.R. §1.137(b)

Because the U.S. designation was inadvertently and unintentionally withdrawn in the international application, the U.S. application became abandoned on January 18, 2005. Applicants respectfully request that the application be revived as an unintentionally abandoned application, and that the accompanying U.S. National Stage application be accepted for processing.

35 U.S.C. §366 states, in relevant part, that if the U.S. designation in an international PCT application is withdrawn, the U.S. designation "shall have no effect after the date of withdrawal, and shall be considered as not having been made." However, 35 U.S.C. §366 does not preclude grant of the instant petition and filing of the accompanying U.S. National Stage application.

A. Withdrawal of the Designation, and Thus Abandonment of the National Stage Application, Was Unintentional

Although the U.S. designation was withdrawn during the international stage of the PCT application, that withdrawal of the designation, and thus the resultant abandonment of

the U.S. National Stage application, was unintentional. The instant Petition accordingly requests that the withdrawal be treated as not having occurred and thereby not implicating the provision of 35 U.S.C. §366.

Because filing of the withdrawal was inadvertent and unintentional, this Petition requests that the withdrawal in effect be treated as a nullity, just as any other petition to revive an unintentionally abandoned application requests that the abandonment be excused to avoid implication of otherwise statutory bars for filing the required response. That is, the present Petition does not request that the provision of 35 U.S.C. §366 be waived or ignored. Rather, the present Petition only requests that the underlying withdrawal of the U.S. designation, which would raise the implications of 35 U.S.C. §366, be treated as a nullity. This is comparable, for example, to excusing the late payment of an Issue Fee after the three-month due date (*see* 35 U.S.C. §151) or late filing of a response to an Office Action after the six-month due date (*see* 35 U.S.C. §133), both of which are outside of the statutory period for such payment or response.

Comparable support for this request appears, for example, in the late payment provision of 35 U.S.C. §151. §151 states, in the context of delayed payment of an Issue Fee, that if the Issue Fee is paid along with a Petition for late payment of the fee, then "it may be accepted by the Director as though no abandonment or lapse had ever occurred" (emphasis added). Although this language does not appear in either 35 U.S.C. §133 (for late response to an Office Action) or 37 C.F.R. §1.137, a similar situation is presented when any abandoned application is revived -- namely, the response and Petition are accepted and the application is treated as though no abandonment had occurred.

Accordingly, it would be proper in the instant case to grant the present Petition and accept the U.S. National Stage application for processing, and without implicating the

provisions of 35 U.S.C. §366 because the application is treated as though the abandonment (i.e., the withdrawal of the U.S. designation) had never occurred.

B. Abandonment of the National Stage Application, By Not Filing the
the National Stage Application Prior to the Withdrawal, Was Unintentional

Alternatively, if the underlying withdrawal of the U.S. designation is not revoked or treated as a nullity, then this Petition should be treated as requesting that the delay in filing the U.S. National Stage application as from before the withdrawal of the U.S. designation occurred be excused as unintentional.

35 U.S.C. §366 also provides that the withdrawal of the U.S. designation "shall have no effect ... and shall be considered as not having been made" if such withdrawal occurs "before the applicant has complied with the applicable requirements prescribed by section 371(c) of this part." Accordingly, had the U.S. National Stage application been filed on or before the unintentional withdrawal of the U.S. designation, the U.S. National Stage application would have proceeded unaffected by the inadvertent and unintentional withdrawal of the U.S. designation. Failure to file the U.S. National Stage application on or before the inadvertent and unintentional withdrawal of the U.S. designation was unintentional, and provides a second ground for grant of this Petition.

Applicants had desired and intended to file a U.S. National Stage application during pendency of the international application. Because filing of the withdrawal of the U.S. designation itself was inadvertent and unintentional, then failure to timely file the U.S. National Stage application before the inadvertent and unintentional filing of the withdrawal of the U.S. designation was also unintentional. Thus, even if the withdrawal is not treated as a nullity, the U.S. National Stage application could timely have been filed any time prior to the withdrawal, and the failure to so file the U.S. National Stage application prior to withdrawal of the U.S. designation was unintentional.

C. Conclusion

For all of these reasons, Applicants request that the instant Petition be granted, and that the failure to file the U.S. National Stage application prior to the inadvertent and unintentional withdrawal of the U.S. designation be treated as an unintentional delay and unintentional abandonment. As a result, entry and consideration of the accompanying U.S. National Stage application are respectfully requested.

III. Petition Under 37 C.F.R. §1.182

Alternatively, Applicants respectfully request that the inadvertent and unintentional withdrawal of the U.S. designation be treated as a nullity under the provisions of 37 C.F.R. §1.182.

37 C.F.R. §1.182 provides that relief in "[a]ll situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director." The situation described above warrants consideration by the Director and a grant of the requested relief.

Although the PCT, its associated regulations, and 35 U.S.C. §366 provide for the withdrawal of a designation in an international PCT application, none of those provisions addresses the situation where the withdrawal is inadvertent or unintentional. In the present case, entry and enforcement of the withdrawal would impose severe prejudice and hardship on Applicants, because the withdrawal of the U.S. designation, rather than the intended withdrawal of the Japan designation, was entirely inadvertent and unintentional.

Appropriate relief in this situation would be revival of the abandoned application, for all of the reasons described above. Alternatively, appropriate relief would be to not recognize the withdrawal of the U.S. designation, on the basis that the withdrawal was inadvertent and unintentional. As described above, the statute and rules provide relief for unintentional abandonment of an application for a variety of reasons in the case, as here, where an

application was properly filed but thereafter unintentionally abandoned. Similar relief in the instant application is warranted. Because the statute and rules do not preclude the requested relief, the relief should be granted to avoid undue prejudice to Applicants.

For all of these reasons, Applicants request that the instant Petition be granted, and that the withdrawal of the U.S. designation be treated as a nullity. As a result, because the international application would be treated as still designating the United States, entry and consideration of the accompanying U.S. National Stage application are respectfully requested.

IV. Accompanying Submissions and Verified Statement

Applicants hereby provide the following required items for a grantable petition:

(1) Petition Fee.

Please credit or debit deposit account number 15-0461 in the amount of the appropriate large entity petition fee as needed to ensure consideration of this petition.

(2) Proposed Response and/or Fee.

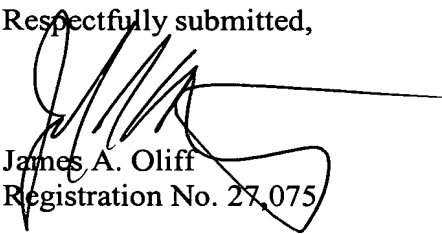
The proposed response and fee in the form of a U.S. National Stage Application, executed Declaration and U.S. National Stage basic filing fee are enclosed herewith. Attached is our Check No. 178965 for \$300.00 for the U.S. National Stage basic filing fee. The remaining fees (basic search fee, basic examination fee, and any extra claim fees) will be paid in response to a Notification of Missing Requirements following grant of this Petition.

(3) Verified Statement.

The abandonment of the U.S. National Stage application, and the entire delay in filing this U.S. National Stage Application from its due date until the filing of this grantable petition was unintentional.

Applicants submit that the requirements for a grantable Petition to Revive Unintentionally Abandoned Application have been met. Accordingly, applicants respectfully request that this petition be granted and that examination of the U.S. National Stage Application commence.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Joel S. Armstrong
Registration No. 36,430

JAO:JSA/nxy

Date: April 18, 2006

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

Attachments:

U.S. National Stage Application and Transmittal Letter
Executed Declaration
U.S. National Stage Basic Filing Fee